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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,401	12/09/2003	Lisa C. Tidwell	1DATA.098A	4514

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EXAMINER

CAPUTO, LISA M

ART UNIT	PAPER NUMBER
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2876

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/16/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/16/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/731,401

Applicant(s)

TIDWELL ET AL.

Examiner

Lisa M. Caputo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. Claims 1-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of copending Application No. 10/731,519, from hereinafter "'519 application". Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1-31 of the instant application, applicants claim an apparatus and method that scores risk associated with accepting a check, and comprises a database to store biometric information, a biometric input device, and a computer processor configured to obtain via the biometric input device biometric information from a check presenter, and determining a risk score associated with cashing the check based at least in part on biometric information associated with the check presenter. Claims 1-49 of the '519 application recite a point of sale device configured to obtain information about a payroll check, such as a watermark, and biometric information about the presenter. Further, a check authorization system is contacted to determine the level of risk associated with cashing the payroll check. Although the scope of claims 1-31 of the instant application, and claims 1-49 of the '519 application are similar, they differ in that claims 1-31 of the instant application are a broader recitation of claims 1-49 of the '519 application (i.e. the '519 application utilizes more identification information). Thus, with respect to the above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use claims 1-49 of the '519 application as a general teaching to arrive at the risk scoring invention of the present application.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by

Robinson (U.S. Patent No. 6,957,770).

Robinson teaches a system and method for biometric authorization for check cashing. Regarding claims 1, 11, and 18, Robinson teaches an apparatus (merchant station 24, 28) that scores risk associated with accepting a check or negotiable instrument, the apparatus comprising a database (merchant/local database 23) that stores biometric information, a biometric input device (Biological Identification Device (BID) 26, 30), and a computer processor (within the merchant terminal) configured to obtain via the biometric input device biometric information from a check presenter desiring to cash a check, the computer processor further configured to determine a risk score associated with cashing the check based at least in part on the biometric information associated with the check presenter (by accessing a central database as well). It should also be noted that a central database 32 is connected to the merchant local terminal 32 via a network. The risk score here is determined by the approval parameters, i.e. if there are negative factors, or warning information regarding either the financial information or the biometric information obtained (see Figures 1-2, col 5 line 45 to col 6 line 40, see Figure 3, col 8, lines 15-40).

Regarding claim 2, Robinson teaches that the biometric input device is configured to obtain at least one of the set consisting of fingerprint, voice sample, iris scan, retina scan etc. when it is taught that the BID 26, 30 may be a fingerprint reader, a voiceprint reader, an iris recognition device, or any other type of biological identification device known in the art (see col 5, lines 50-55).

Regarding claim 3, Robinson teaches that the computer processor is configured to compare the biometric information from the check presenter with the stored biometric

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information when it is taught that all transaction data is sent to the invention's central database 60, and the consumer's biometric scan is compared to various other biometrics within the system for potential matches (see Figure 3, col 8, lines 15-40).

Further, regarding claims 4-10, 13-17, 19-23, 25, and 30-31, Robinson teaches a method and system of scoring risk associated with accepting a risk transaction when it is taught that, referring to FIG. 3 a flow chart of a transaction process according to an embodiment of the present invention is illustrated. The consumer desiring to cash a check provides their biometric 54. The merchant then slides the check through a check reader 56 and keys in the amount of the check and any other desired information, such as the date or an image scan of the check 58. All transaction data is sent to the invention's central database 60, and the consumer's biometric scan is compared to various other biometrics within the system for potential matches. In addition, at least one field of information on the presented check is checked against one field in the list of checks previously presented into the system. Once a match for the consumer's biometric is found and approval parameters (risk score as taught in the instant invention), such as the compared check field not containing negative or warning information, are met, the invention's central database sends notice to the local device that the consumer has been positively identified and the transaction has been approved 62. If either the consumer or the checking account number produces a negative match, the transaction will be declined with a reason. In addition, if the consumer is found in the warning database and no negative check information is found, the merchant may accept or decline the transaction at the merchant's discretion. The merchant's decision also

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may be automated by pre-set parameters (i.e. risk factors). The risk score here is determined by the approval parameters, i.e. if there are negative factors, or warning information regarding either the financial information or the biometric information obtained (see Figure 3, col 8, lines 15-40). In addition, Robinson provides a system guarantee service which allows merchants to cash checks with a smaller risk of losing money on fraudulent checks cashed (see col 9, lines 5-20).

Regarding claim 12, the negotiable instrument is at least one of a personal check, corporate check, payroll check, etc. when it is taught that a consumer attempts to cash a check, or further, that a merchant can decide to accept or not accept payroll checks (see col 8, lines 15-20, col 10, lines 13-32).

Regarding claim 24, Robinson teaches that the stored biometric input is obtained during a registration transaction with the payee when it is taught that a consumer may complete a full enrollment registration for the invention's services at any merchant station 24, 28 equipped with the BID 26, 30 (see Figure 1, col 5, lines 44-47).

Regarding claims 26-29, Robinson teaches that the database (merchant local terminal 23) and computer processor (within the merchant terminal) are located at the entity location, which utilizes check authorization. In addition, the database (central database 32) and computer processor (merchant terminal) can be located at a third party biometric evaluation service since there is a plurality of merchant terminals. Further, the database comprises a repository of fingerprint information (see Figures 1 and 3, col 5, line 12 to col 6 line 25, col 8, lines 15-40).

Examiner's Note

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3. Examiner has cited particular column and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the Applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the Prior Art or disclosed by the Examiner.

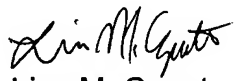
Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398**. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**lisa.caputo@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lisa M. Caputo
AU 2876
January 5, 2007